

REMARKS

Applicant has received and carefully reviewed the Final Office Action mailed on August 23, 2006. Claims 3-18 are pending, with claims 3-11 and 13 amended and claims 15-18 newly presented as set forth above. Reconsideration and reexamination are respectfully requested.

In paragraph 2 of the Final Office Action, claims 3 and 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,071,030 to Hunter et al. in view of U.S. Patent No. 5,040,216 to Policht. After careful review of the cited references, and in view of the above amendments, Applicant respectfully disagrees.

The outstanding rejection states that "Hunter teaches the step of providing a blank photo-grade sheet 110, and attaching a hinge strip mounted along an edge of the printer paper sheet." It appears, however, that the Hunter et al. reference does not teach using both a sheet and a hinge strip as recited. Instead:

FIG. 5 illustrates a one-piece divider assembly 110 which can be folded over at the binding edge thereof and which includes the previously-mentioned adhesive strip 64. The assembly 110 is suitable for printing in laser printers, ink-jet printers, photocopiers and other printers such as shown in FIGS. 2 and 11. The assembly 110 has a binding edge 112 and an integral, debossed binding edge region 114 extending inwardly into the sheet from the binding edge. The assembly also has a main body 116 with an integral, outwardly extending tab 118. A heavy paper or cardstock sheet forms the structural basis for the entire divider assembly 110.

(Hunter et al. at column 6, lines 52-62). By stating that the edge region 114 is "integral", Hunter et al. appear to indicate that, instead of starting with two pieces, Hunter et al. use a single piece of paper with a debossed edge. This distinction between the claim and the cited reference is not addressed in the rejection. Applicant acknowledges that the disclosure of Policht may address certain aspects of this portion of the rejection, however, the burden of establishing a *prima facie* case of unpatentability lies with the Examiner. Policht suggests using an irregularly shaped binding member, while Hunter et al. appear to emphasize the importance of having a regular shape to the perimeter of a paper that passes through a printer. Thus, at least at a glance, Policht and Hunter et al. appear poorly suited to combination on this point, and the combination at least appears unobvious. As a rejection on this further basis has not been stated, Applicant will not further belabor the point.

Applicant believes that the above illustrates that a *prima facie* case of unpatentability has not been made. However, to advance prosecution, Applicant has amended the claims. In particular, independent claim 3 has been amended to recite, in part, “providing an assembly of a blank sheet and a hinge strip spaced apart by a gap from the edge of the blank sheet and connected by connecting strips thereto.” Hunter et al. merely discloses a folding line or score line, which is described as follows:

The binding edge region 114 has a folding portion 120 which has spaced ring apertures 122. The binding edge region 114 may also have a non-folding portion 124. The folding portion 120 and non-folding portion 124 are separated by a folding line 126, about which the folding portion may fold. Longitudinal folding line 126 is inset from and runs parallel to the binding edge 112. In the embodiment of FIG. 5, the folding line 126 is scored to improve the regularity and proper positioning of the fold. Such scoring may consist of notches, cuts or a single indented line as best shown in FIG. 6.

(Hunter et al. at column 6, line 63 to column 7, line 6, emphasis added.) In Figure 6, the folding line can also be a line of indentation. (Hunter et al. at column 7, lines 13-15.) Thus, Hunter et al. do not teach a “gap” as is now recited, either.

Much of the background section of Hunter et al. is directed toward explaining problems, particularly with “skew” and jamming in printers, with the prior art. As explained in the above quotation, Hunter et al. teach a specific longitudinal folding line to improve the regularity and proper positioning of the fold. If a rejection similar to that already stated is to be maintained in reliance on Hunter et al., Applicant notes that providing a gap in place of the “folding line” in Hunter et al. would undermine the regularity and proper positioning of the fold within the dimensions of the gap.

In light of the above, it is believed that the cited combination does not render claim 3 unpatentable. Further, independent claim 10 has been amended in similar fashion and for at least similar reasons, claim 10 is believed to be patentable over the cited combination. Therefore it is believed that the rejections of claims 3 and 7-12 are overcome.

In paragraph 3 of the Final Office Action, claims 4, 6, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. in view of Policht and further in view of U.S. Patent No. 4,207,366 to Tyler. The Tyler reference is relied upon only to provide particulars of the type of paper used. Applicant believes that the above remarks indicate that the Hunter et al. reference cannot be appropriately modified in view of other references to render the

current claims unpatentable. Therefore it is believed that a *prima facie* case of unpatentability does not exist, and the rejection of claims 4, 6, 13 and 14 has been overcome.

In paragraph 4 of the Final Office Action, claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. in view of Policht and further in view of U.S. Patent No. 6,332,953 to Singh et al. As already indicated, it is believed that each rejection under 35 U.S.C. §103(a) that relies on Hunter et al. has been overcome, as modification to match the pending claims is non-obvious. Therefore it is believed that the rejection of claim 5 is also overcome.

Applicant has added new claims 15 and 16, which recite that the gap has a certain width. This width was identified in the originally filed application as being advantageous for ease of viewing photographs and ease of turning pages. It is believed that claims 15 and 16 are in condition for allowance.

Applicant has also added new claims 17 and 18, which each recite that the blank sheets of the independent claims are of photo-grade material. This terminology has been removed from the independent claims. Applicant has submitted affidavits and evidence that the International Standards Organization has identified a definition for the phrase “photo-grade.” As such, it is a term of art, known and used by those of skill in the art. The submitted affidavit clearly indicates that the materials suggested in the Hunter et al. reference are not “photo-grade.” In light of Applicant submissions, it is impermissible for the Examiner to treat the term “photo-grade” as not adequately defining “what quality of photo is enough to meet this limitation.” First, the quality of the “photo” is not recited; instead, it is the material of the blank sheet that is being described. The ISO evidence and the Affidavit establish that, to those of skill in the art, not only does this terminology have a particular meaning, but the materials in the Hunter et al. reference do not fall within that meaning.

The MPEP clearly sets forth the standard that should be applied:

“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.”

MPEP 2111.01(III) (citations omitted). Applicants have established the ordinary and customary meaning of the claim term with the submitted evidence and affidavits. Therefore it is believed that claims 17 and 18 are patentable over the cited references.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

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